

REMARKS

Claims 35-44, 47-51, 55-56, 58, 64-65, 67, 69-70, 107, 110, and 120 are amended, and claims 1-3, 5-27, 45, 52, 57, 59-63, 78, 87-106, and 108 are canceled. The amendments are intended to advance the application and are not intended to concede to the correctness of the Examiner's position or to prejudice the prosecution of the claims prior to amendment, which claims are present in a continuation of the present application. Claims 35-44, 46-51, 55-56, 58, 64-67, 69-77, 107, and 109-120 are now pending in this application.

In the Office Action dated March 14, 2006, the Examiner noted that claims 110-120 were allowed, claims 5, 9, 108 and 109 were objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims, and claim 119 was objected to under 37 C.F.R. § 1.75 as being a substantial duplicate of claim 9. The cancellation of claims 5, 9 and 108 obviate the objection to those claims. It is unclear why claim 109 is objected to as it is an independent claim.

Applicant respectfully requests rejoinder of claims 35-44, 46-51, 55-56, 58, 64-67, and 69-77 (methods of using a dehalogenase susbtrate), with elected claims 107 and 109-120.

Claims 1-3, 5-11, 15, and 107-120 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. With regard to the number of carbon atoms in the linker, the Examiner is requested to note that the linker in R-linker-A-X is a divalent branched or unbranched carbon chain comprising from 2 to 30 carbon atoms, which chain optionally includes one or more double or triple bonds, and which chain is optionally substituted with one or more hydroxy or oxo (=O) groups, wherein one or more of the carbon atoms in the chain is optionally replaced with a non-peroxide -O-, -S- or -NH-, wherein the linker-A separates R and X by at least 11 atoms, wherein A is $(CH_2)_n$ and n = 2-10. Accordingly, the linker may include 2 carbon atoms in the divalent branched or unbranched chain and A includes at least 2 carbon atoms.

The cancellation of claims 1-3, 5-11, 15, and 108, and the amendments to claims 107 and 120, render the § 112(2) rejection moot.

Claims 1-3 and 6-8 were rejected under 35 U.S.C. § 102(b) as being anticipated by Bennetau et al. (WO 01/53303). Claims 1-3, 6-8, 11, 15, and 107 were rejected under 35 U.S.C. § 102(b) as being anticipated by Morita et al. (U.S. Patent No. 4,818,807). Claims 1-3, 6-8 and 107 were rejected under 35 U.S.C. § 102(b) as being anticipated by Lustori et al. (CS 259396). Claims 1-2, 6-8, and 10-11 were rejected under 35 U.S.C. § 102(b) as being anticipated by Morzycki et al. (Tetrahedron, 53:10579 (1997)). The cancellation of claims 1-3, 6-8, 10-11 and 15, and the amendments to claim 107, obviate the § 102(b) rejections.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (612) 373-6959 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

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CERTIFICATE UNDER 37 CFR § 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 11th day of July 2006.

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